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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,504	08/05/2003	David J. Alverson	0131-1	8679

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EXAMINER

CHOI, PETER H

ART UNIT PAPER NUMBER

3623

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,504

Applicant(s)

ALVERSON ET AL.

Examiner

Peter Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-Final Office action is response to Applicant's response to Applicant's amendment filed. Applicant's amendment of March 14, 2005 amended the specification and claim 6. Currently, claims 1-11 are pending.

Response to Amendment

2. Applicant's amendment filed on March 14, 2005 with respect to amended claim 6 necessitated new ground(s) of rejection.

Response to Arguments

3. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues the claims as amended, which will be addressed in the revised art rejection found below.

Examiner notes that the applicant did not challenge the Official Notice or dispute the validity of concepts old and well-known in the art as cited in the First Office Action, therefore those statements are presented herein as prior art. Specifically, it has been established that:

- Results derived from a questionnaire or auditing process are quantifiable and therefore allows a number of statistical means, including graphs, to be used in an analysis or comparison.
- Graphical representations of data can be used as a method of comparison.
- The concept and advantages of providing for displays with recognize a contractor's services exceeding industry standards is old and well known in the art.
- Contractors who receive recognition or certification would adapt symbols of recognition, certification, or similar awards for use in promotion of their business, whether it be on stationary, the company website, or other mediums of advertising.
- Contractors (and firms) subjecting themselves to assessment, evaluation or certification will receive some sort of notification (usually in written form) regarding their performance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is direct to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces useful, concrete and tangible results.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. The claimed invention is not within the technological arts – i.e., no computer implementation or other technology is employed.

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In the present case, none of the recited steps in claims 1-10 are directed to anything in the technological arts as explained above. Looking at the claims as a whole, nothing in the body of the claims recites any structure or functionality to suggest that a computer (or any other technological component) performs the steps. Furthermore, the recited steps of evaluating a contractor's business on-location, and mapping, comparing, and reporting evaluation results do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed by use of a pencil and paper.

Specification

6. The applicant has amended the specification. The Pickens and Thompson patents are now correctly described. The previous objection of the specification is withdrawn.

Claim Rejections - 35 USC § 112

7. Claim 6 has been amended by the applicant and is now compliant with 35 USC § 112. The previous rejection of claim 6 under these grounds are withdrawn.

Claim Rejections - 35 USC § 103

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 - 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aycock et al. (Patent No. #5,765,138) in view of GuruNet's "Business Evaluation Statements" (herein referred to as GuruNet), further in view of Bladen et al. (Patent Application No. #US2002/0099586A1).

As per claim 1, Aycock et al. teaches a contractor certification (supplier evaluation) system comprising:

(a) survey means comprising a questionnaire (RFP/RFQ), which is provided to selected candidates (suppliers that desire to be qualified as vendors) within a contractor's business for assessing business (service and support) and financial practices; (price and availability) (Column 6, lines 1-9)

(c) on-location assessment (on-site audit) means for determining (validating) business practices at the contractor's operations; (Column 7, lines 62-65)

(d) comparison means (risk assessment) for assessing business practices (technical capabilities), and ranking the contractor in comparison with industry standards; (Column 8, lines 58-63)

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(e) reporting means (product database) for providing a grade indicative of said contractor's rank (competitive analysis of all vendors to determine the respective performance); (Column 9, lines 59-67 and Column 10, lines 1-17)

However, Aycock et al. fails to teach assessment means for determining the financial practices of a contractor's operations. GuruNet teaches a set of assessment statements that can be used to evaluate the financial practices (**paying bills, collecting receivables, budget analysis, accounting systems, sources of capital, cost efficiency, minimization of costs, cash flow levels**) of a company [Retail Questions 72-74, 76-89, 127, Manufacturing Questions 57-68, 123, Wholesale Questions 67-83, 126, Service Questions 71-85, 98-100 and 138]. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Aycock et al. to include the means taught by GuruNet to evaluate the financial practices of a company as it is a factor utilized by surety institutions in determining credit rates, loan rates, and loan amounts.

The combined teachings of Aycock et al. and GuruNet fail to teach a mapping means for studying answers provided to a questionnaire. Bladen et al. teaches a risk assessment system where performance can be compared against an industry benchmark using trend analysis graphs of results. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Aycock et al. to include a mapping means since it is quite advantageous for these graphs to be used to

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compare the overall performance of a contractor to industry standards or competitors, or to map their individual strengths and weaknesses (Stage 2 of Paragraph 0461).

As per claim 2, although not taught by Aycock et al., GuruNet teaches a contractor certification (**company evaluation**) system with a questionnaire (list of statements) composed of non-threatening (objective) questions. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Aycock et al. to include the questionnaire as taught by GuruNet to obtain information necessary to conduct an analysis of a company's practices.

As per claim 3, although not taught by the combined teachings of Aycock et al. and GuruNet, Bladen et al. teaches a contractor certification (risk assessment) system where the mapping means (graphs of results) develops, within answers to questions, areas comprising clear matches, clear discrepancies and inadequate details for on location assessment. (Paragraph 0345)

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the combined teachings of Aycock et al. and GuruNet to include a mapping means to compare the results of a contractor in a particular aspect or the response to a particular question from the questionnaire, since results from a questionnaire can be quantified and graphed, and the graphs may highlight strengths or weaknesses of a contractor in comparison to competitors or industry standards.

As per claim 4, Aycock et al. teaches a contractor certification (supplier evaluation) system where the on-location (on-site) assessments (evaluations) comprise job site visits (on-site audit). (Column 3, line 36 and Column 8, lines 20-24)

As per claim 5, Aycock et al. teaches a contractor certification (supplier evaluation) system where the comparison means comprises an evaluation of the contractor's business practice data against one or more databases containing performance and risk factor data from similar contractors (existing and historical vendor performance and on-site audit reports), stored by the contractor certification (supplier evaluation) system. (Column 9, lines 38-57)

As per claim 6 and 11, the combined teachings of Aycock et al., GuruNet, and Bladen et al. are silent regarding the use of a special logo or insignia to represent the caliber of a contractor's work or the successful completion of the certification program. However, the concept of providing for a display that recognizes that a contractor's services exceed industry standards is well known and accepted as a prior art practice. It is also prior art practice that contractors who receive recognition or certification would adapt it for use in promotion of their business, whether it be on stationary, the company website, or other mediums of advertising.

It has been established in the prior art that when a contractor (or any firm) subjects itself to assessment, evaluation, or certification, the firm will receive some sort of notification (usually in written form) regarding their performance. This notification will entail the findings of the assessment, evaluation, or certification, and can be used by surety institutions in underwriting loans to the contractor.

As per claim 7, the teachings of Aycock et al. fail to disclose the composition of the administered questionnaire. However, GuruNet teaches a series of business evaluation statements that comprises questions directed to organizational aspects with particular reference to management structure [Retail Questions 42,43,52-59,89], authority delegation [Retail Questions 44-45, Manufacturing Question 92, and Wholesale Questions 40-41], and decision-making practices [Retail Questions 49, Manufacturing Questions 31, and 37, Service Questions 39-40,]. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Aycock et al. to include questions directed to management structure, authority delegation, and decision-making practices as taught by GuruNet to obtain an understanding of key organizational aspects that impact the daily operations of the company, making it possible to compare practices with the practices of other firms.

As per claim 8, the teachings of Aycock et al. fail to disclose the composition of the administered questionnaire. However, GuruNet teaches a series of business evaluation statements that comprises questions directed to managerial aspects with

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particular reference to marketing [Retail Questions 1-4 and 6-13, 114-117, 132, Manufacturing Questions 3,7,9-10,12, 112-114, Wholesale Questions 1-11, 13, 115-117, and Service Questions 2-8, 10-12, and 125-127].

Although GuruNet does not teach any questions regarding a company's bidding process and project execution practice, Official Notice is taken these practices are vital components in defining a company's management practices and an evaluation of these practices would be needed to formulate a comprehensive assessment that can be used to compare the company with other companies.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Aycock et al. to include questions directed to marketing, bidding processes, and project execution practices as taught by GuruNet to obtain an understanding of key managerial aspects that impact the daily operations of the company, making it possible to compare practices with the practices of other firms.

As per claim 9, Aycock et al. teaches a contractor certification (supplier evaluation) system as recited by claim 5, where the database (vendor database) stored comprises a compilation of business and financial and risk data derived from contractors previously evaluated (existing and historical vendor performance or on-site audit reports). (Column 9, lines 38-57)

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As per claim 10, Aycock et al. teaches a contractor certification (supplier evaluation) system as recited by claim 6, where the comparison report (vendor performance report) sets forth said contractor's business practices (vendor performance and on-site audit reports) with detail sufficient to assist surety institutions engaged in underwriting a contractor's credit line. (Column 9, lines 38-57)

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Women's Business Center teaches a quiz to compare a company's financial management practices with that of successful companies.

In The Physician's News Digest, Joan Roediger teaches means of benchmarking internal practices by studying the income statements, financial statements, balance sheets, productivity and accounts receivable information. An analysis of financial soundness, overhead expenses, services, and production are a few of the business health indicators analyzed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (571) 272 6971. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PL

June 10, 2005



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